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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/545,088	04/07/2000	Charles Gilbert Heisinger JR.		1969

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EXAMINER

FLEURANTIN, JEAN B

ART UNIT	PAPER NUMBER
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2172

DATE MAILED: 10/06/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/545,088

Applicant(s)

HEISINGER, CHARLES GILBERT 

Examiner

Jean B Fleurantin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE September 3, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-40,44 and 47-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-40,44 and 47-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 3, 2003, has been entered. Claims 36-64 remain for examination.

Specification

2. Applicant is advised to delete the underline title on the abstract portion (abstract page). See MPEP 608.01(f).

Response to Applicant's Remarks

3. Applicant's arguments submitted on September 3, 2003 with respect to claims 36-64 have been fully considered but they are not persuasive. For the following as indicated:

In response to applicant's argument on page 7 and 8, that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Marwell does not

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explicitly disclose the steps of sending at least a portion of the retrieved user information via electronic message, and wherein the first and second databases are used to create the electronic message. However, Foladare discloses there may be a separate device for determining the portions of the electronic mail message to be sent for each of the receiving party's electronic mail receiving devices 120-150 and to compile these portions into a message to be sent to the electronic mail receiving devices, (see cols. 4-5, lines 63-1). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify teachings of Marwell and Foladare with steps of sending at least a portion of the retrieved user information via the electronic message, and wherein the first and second databases are used to create the electronic message. Such modification would allow the teachings of Marwell and Foladare to improve the accuracy and the reliability of the method and system for telephonically selecting, addressing, and distributing messages, and provide a centralized electronic mail service method and apparatus in which selected portions of an electronic mail message is sent to each of a subscriber's electronic mail addresses, (see col. 1, lines 32-35)..

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Claim Rejections - 35 U.S.C. § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 36-40, 44, 47-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,404,884 issued to Marwell et al. (hereinafter "Marwell") in view of U.S. Patent No. 6,311,210 issued to Foladare et al. (hereinafter "Foladare").

As per claim 36, Marwell discloses a method of addressing an electronic message (see col. 14, lines 23-25), comprising the step of providing a first database containing stored telephone numbers and user information corresponding to each of the stored telephone numbers (see cols. 1-2, lines 66-3, as a first database stores the list of personal contact data and the list of personal contact data stored in the first database is updated with the personal contact update data received by the web server);

providing a second database containing identification codes and addressing information corresponding to each identification codes (see col. 6, lines 19-26, as the personal contact list tables preferably store contact names and numbers for each corresponding user and the personal contact list can also be arranged to include more detailed information about each contact, such as electronic and surface mail addresses,

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job title, company name, company address, facsimile telephone number and home web page address in which each entry in a contact list is assigned a unique identification number);

receiving a telephone call from a user including one of the identification codes (see col. 3, lines 40-43, as a means for using a telephone to contact a service for searching a database for desired information and performing an operation requested by a user is provided in which, a telephone number associated with the service is called);

identifying the received telephone number from the telephone call (see col. 3, lines 45-46, as the database is searched for a contact list corresponding to an identification number of the calling telephone);

retrieving the user information from the first database by comparing the receiving telephone number with the stored telephone numbers (see col. 3, lines 40-43, as a method for using a telephone to contact a service for searching a database for desired information and performing an operation requested by a user is provided in which in which a telephone number associated with the service is called);

retrieving the addressing information corresponding to the received identification code (see cols. 9-10, as a means for retrieving the personal contact list associated with the caller's telephone id);

addressing the electronic message according to the retrieved addressing information (see col. 12, lines 37-39, as the user can send an electronic mail from user terminal ten to web server 68 describing their desired changes in detail). Marwell does not explicitly disclose the steps of sending at least a portion of the retrieved user information via electronic message, and wherein the first and second databases are used

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to create the electronic message. However, Foladare discloses a separate device for determining the portions of the electronic mail message to be sent for each of the receiving party's electronic mail receiving devices 120-150 and to compile these portions into a message to be sent to the electronic mail receiving devices, (see cols. 4-5, lines 63-1). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combined teachings of Marwell and Foladare with steps of sending at least a portion of the retrieved user information via the electronic message, and wherein the first and second databases are used to create the electronic message. Such modification would allow the teachings of Marwell and Foladare to improve the accuracy and the reliability of the method and system for telephonically selecting, addressing, and distributing messages, and to provide a centralized electronic mail service method and apparatus in which selected portions of an electronic mail message is sent to each of a subscriber's electronic mail addresses, (see col. 1, lines 32-35).

As per claims 37 and 48, Marwell discloses, wherein the electronic message is a fax, (see col. 18, lines 65-66).

As per claims 38 and 49, Marwell discloses, wherein the electronic message is an email, (see col. 18, lines 65-66).

As per claims 39 and 50, Marwell discloses, wherein the electronic message is a voice mail (see col. 2, lines 1-2, as a voice activated dialing).

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As per claims 40 and 51, As per claims 42 and 53, Marwell discloses, wherein the user information includes payment instructions and the payment instructions are sent via the electronic message (see col. 18, lines 42-43, as user will establish a payment profile in database sixteen including bank account information).

As per claim 44, the limitations of claim 44 are rejected in the analysis of claim 57, and this claim is rejected on that basis.

As per claims 47 and 56, in addition to the discussion in claim 36, Marwell further discloses an ANI for identifying the received telephone number from the telephone call (see col. 10, lines 20-31, as a CSR terminal 18 as an automatic number identification (ANI) data string).

As per claim 52, the limitations of claim 51 are rejected in the analysis of claim 36, and this claim is rejected on that basis.

As per claim 53, Marwell discloses the step of including a second processor and wherein the second processor retrieves the user address from the electronic message (see col. 12, lines 37-39, as the user can send an electronic mail from user terminal ten to web server 68 describing their desired changes in detail).

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As per claim 54, Marwell discloses, wherein the second processor sends a second electronic message to the user (see col. 18, line 63, as a means for sending electronic mails).

As per claim 55, Marwell discloses, wherein the second electronic message includes an advertisement, (see col. 18, lines 64-66).

As per claim 57, in addition to the discussion in claim 36, Marwell further discloses purchasing the product based upon the user information retrieved from the first database and the product information retrieved from the second database (see col. 18, lines 10-16, as the user can store his or her clothing sizes in database sixteen and use system two to contact a customer service representative to arrange for purchase of a pair of pants in which the customer service representative has access to a number of vendors whose relevant data is stored in database sixteen, telephone number, store location and price).

As per claim 58, Marwell discloses, wherein user information includes address information, (see col. 18, lines 20-23).

As per claim 59, Marwell discloses, wherein address information includes shipping information, (see col. 14, lines 34-49).

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As per claims 60 and 61, Marwell discloses, wherein address information includes billing information (see col. 18, lines 42-46, as a means for including bank account information).

As per claim 62, Marwell discloses, wherein payment instructions include credit card information (see col. 18, lines 41-46, as a means for including bank account information).

As per claim 63, Marwell discloses the step of shipping the product, (see col. 18, lines 22-23).

As per claim 64, Marwell discloses, wherein shipping information includes delivery method information (see col. 18, lines 20-23, as a contact addresses).

Prior Art

5. The prior art of record and not relied on upon is considered pertinent to applicant's disclosure. Linstead et al. U.S. Patent No. 5,548,753 relates to a method for communicating information in a database.

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Contact Information

6. Any inquiry concerning this communication from examiner should be directed to Jean Bolte Fleurantin at (703) 308-6718. The examiner can normally be reached on Monday through Friday from 7:30 A.M. to 6:00 P.M.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Mrs. KIM VU can be reached at (703) 305-8449. The FAX phone numbers for the Group 2100 Customer Service Center are: *After Final* (703) 746-7238, *Official* (703) 746-7239, and *Non-Official* (703) 746-7240. NOTE: Documents transmitted by facsimile will be entered as official documents on the file wrapper unless clearly marked "***DRAFT***".

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 2100 Customer Service Center receptionist whose telephone numbers are (703) 306-5631, (703) 306-5632, (703) 306-5633.



Jean Bolte Fleurantin

September 30, 2003

JBF/